

### **REMARKS/ARGUMENTS**

Applicants would like to thank the examiner for the careful consideration given the present application. Claims 1-39 have been canceled without prejudice. New claims 40-45 are added without adding any new matter. Applicants respectfully request reconsideration and allowance.

Claims 40-51 remain in this application. Claims 1-39 have been previously canceled. Claims 40, 42, 44 and 45 have been amended without adding any new matter. Furthermore, new claims 46-51 have been added.

Claims 46-48 and 50-51 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. For the following reasons, the rejection is respectfully traversed.

The Examiner argues that the specification doesn't support the feature of claim 46 (as amended) that "the session control server detects the QoS control capability information, informs the central controller and then replies to the terminal with an indication of QoS control capability embedded in an acknowledgement message". However, paragraphs 0067-0071 of the published application in reference to FIG. 3 clearly supports this feature, where it is described that the SIP proxy 25 examines an INVITE message from the terminal indicating whether the terminal has QoS control capability (paragraph 0067), that the SLA manager then informs the SIP proxy to continue the session (paragraph 0068) and (at paragraph 0070) that:

the home SIP proxy 30 would further relay the SIP 183 message also embedded with a QoS control capability tag to the SIP Proxy 25 at the visited network 24 (309: SIP 183 (SDP)). The QoS control capability tag at this acknowledgement

message (SIP 183 message) will tell the terminal 21 that it can start the QoS controller module.

Accordingly, the claim language is supported by the specification, and thus the rejection should be withdrawn.

Similarly, regarding the rejection of claim 47, that “the central controller initiates a monitor session when an access control server informs the central controller of the QoS control service request and then replies to the terminal with an access control reply with tunnelling channel information”, this feature is supported by paragraphs 0097-0101, and in particular at paragraph 0100 that states that the SLA manager initiates the service monitor and QoS control by managing tunneling configurations (see paragraph 0107-0108 discussing the tunneling channel), and thus the rejection should be withdrawn.

Claim 46 was rejected under 35 U.S.C. §112, second paragraph for being indefinite, this claim is corrected by the amendments provided herein, making the rejections moot..

Claim 47 was rejected under 35 U.S.C. §112, second paragraph for being indefinite, as the examiner indicates that it is not clear which element receives the tunneling information. Claim 47 has been amended for clarification to overcome the rejection. Amended claim 47 recites the clause as follows:

wherein, in case that XXX, the terminal receives the tunneling channel information

The “XXX” is the condition found in the claim (i.e., when “the central controller initiates a monitor session when an access control server informs the central controller of the QoS control service request and then replies to the terminal with an access control reply with tunnelling channel information” the terminal receives the tunneling channel information), but it is the

terminal that receives the tunneling information. As claim 47 has been amended, the rejection should be withdrawn.

Claims 40-46, 48, and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Minde *et al.* (U.S. WO 00/33511) in view of Kalliokulju *et al.* (U.S. 6,618,591). Claims 47, 49 and 51 were rejected as above in further view of Rosemarjin *et al.* (U.S. 2002/0151312). For the following reasons, the rejection is respectfully traversed.

Amended Claim 40 recites a communication module configured to report the QoS information collected by the monitor module to a central controller connected to said terminal via the network and receive QoS enforcement instructions from the central controller via the network, *the QoS enforcement instructions being given from the central controller according to the QoS information, subscription information of a user who uses the terminal and service agreement information.* Furthermore, as previously argued, claims 44 and 45 both recite a database connected to the network that is configured to store subscription information of a user who uses the terminal and service agreement information, and sending QoS enforcement instructions from the central controller to the terminal according to the QoS information, the subscription information and the service agreement information. Although the Examiner cites Minde for such a teaching (citing page 11, lines 6-13), the cited section merely describes an end-user threshold, which **does not imply** any giving of QoS enforcement instructions according to QoS information, subscription information and service agreement information, and any storing of subscription information or service agreement information (which is not necessary to exist, for example for free services, and thus cannot be implied by the reference).

The Examiner clearly recognizes this lack of explicit teaching when he states that providing the database is “obvious since predetermined end-user QOS implies subscription and service level agreement”, but as previously pointed out, it is not enough to merely allege that a function or feature is “inherent”. The Examiner has failed to provide any of the required *evidence* or supporting rationale to show inherency. MPEP §2112. The fact that a certain result or characteristic *may* occur or be present in the prior art is *not sufficient* to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art) (emphasis added); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence `must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it *would be so recognized by persons of ordinary skill*. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP §2112.

As previously pointed out, it is not necessarily true that a central database must be provided to store subscription information of a user who uses the terminal and service agreement information just to provide a EuQoS, as a predetermined end user QOS could be globally set (not

user-dependent). Or it could be set based on the program, the circumstances of the broadcaster, the network configuration, etc. It is therefore not necessary that subscription information of a user or service agreement information be stored to use such a parameter, inherency is therefore not legally shown, and thus the feature is not obvious and the rejection is improper, and claims 40, 44 and 45 are patentable over the references.

Furthermore, as also previously pointed out, the claims require that this stored information is used by the central controller to generate the QoS enforcement instructions sent to the terminals. For this, the Examiner cites Fig. 5, item 525, the step of adapt service command based on EuQoS. But again, this step does not specify the use of any *subscription information* or *service agreement information*, as the EuQoS is nothing more than a quality parameter that may be provided independent of user information (as discussed above, it might be set by a supplier or the network provider, for example). End user thresholds are not the same as the cited information required by claims 40, 44 and 45, and thus, claims 40, 44 and 45 are patentable over the reference for these reasons as well.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No.: NIHE-38824.

Respectfully submitted,  
PEARNE & GORDON, LLP

By:           / Robert F. Bodi /            
Robert F. Bodi Reg. No. 48,540

1801 East 9<sup>th</sup> Street  
Suite 1200  
Cleveland, Ohio 44114-3108  
(216) 579-1700

Date: June 29, 2011